

Arguments/Remarks

Claims 1, 7, and 9 are pending in this application, and currently stand rejected. Claims 2-6 are herein cancelled, and claims 10-12 have been previously cancelled. Reconsideration is respectfully requested.

Rejections under 35 U.S.C. §112

Claims 1-9 have been rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter applicants regard as the invention. More particularly, the Examiner notes that the terms "unsubstituted or substituted" are indefinite. In response thereto, Applicants note that it is unclear whether the Examiner finds the terms unsubstituted or substituted unclear, or whether the Examiner understands the terms, but finds the claim indefinite because it is unclear what the possible substitutions are.

In either case however, it is clear to one of skill in the art what the substitutions are which may be used in the presently claimed formula I. The requirement that the claims, "particularly point out and distinctly claim" the invention is met when a person of skill in the art would understand the scope of the subject matter that is patented when the claim is read in conjunction with the rest of the specification. Applicant disagrees that the claims are so unclear as being indefinite or failing to particularly point out and distinctly claim the subject matter of the invention. The action does not explain the basis for the conclusion that the subject phrases fail to satisfy 35 U.S.C. § 112. Nonetheless, applicant has amended the claims to more clearly recite the specific substitutions. The rejection is therefore respectfully traversed.

The Examiner has also rejected claims 1-9 under 35 U.S.C. §112 as failing to comply with the enabling requirement. More particularly, the Examiner notes that only compounds where X-R4 are collectively O-benzyl are exemplified.

Compliance with the enablement requirement however, does not turn on whether an example is disclosed. The specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. See MPEP 2164.02. In the present case, X is disclosed as being O, NH, and S, while R4 is disclosed as a carbon linked R7 group, R7 being one of cyclobutyl, cyclopentyl, cyclohexyl, phenyl, furyl, pyrrolyl, thienyl or pyridyl. Given the disclosed experimental procedure showing the synthesis of O-benzyl compounds, one of skill in the art could certainly make amino and sulphur linked R7 groups as disclosed above. Applicant has nevertheless amended the claims to traverse the rejection. Withdrawal is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1-9 have been rejected under 35 U.S.C. §103 as being obvious over U.S. Patent No. 6,713,474 to Hirst et al. More particularly, the Examiner notes that the difference between the claimed compound and the reference is the position of the X-R4 on the phenyl ring, the 4 position versus Applicant's 3 position.

In applying the test for obviousness to chemically similar structures, the Court of Appeals Federal Circuit recently laid out a standard in *Takeda Chemical Industries Ltd v. Alphapharm Pty. Ltd.* 83 USPQ2d 1169 (Fed. Cir. 2007). The Court stated, "in many cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish a prima facie case of obviousness. ... in order to find a prima facie case of obviousness (for structurally related compounds), a showing that the 'prior art would have suggested making the molecular modifications necessary to achieve the claimed invention' was also required."

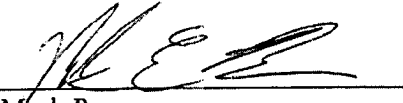
The Examiner rightly states, "whether the compound is buried in a reference or is on the cover of a scientific journal does not matter. A reference, which cites a compound of interest and which is available to the public, is considered relevant."

A reference however, must be viewed as a whole in terms of what it teaches however. In the present case, Hirst broadly discloses close to 600 compounds which are broadly defined as being protein kinase inhibitors. There are at least 400 enzymes identified as protein kinases. Each protein kinase has its own unique structural properties and therefore unique small molecules which would inhibit it. There is no data presented in Hirst suggesting that the compounds contained therein would potentially inhibit IGF-IR, whether it be on its face or in column 130. Absent any data for the compounds, there is not evidence that any compounds included therein would potentially inhibit IGH-IR. It would therefore be a further stretch to suggest that a positional isomer of such a compound would inhibit IGF-IR, since the compounds themselves have not been demonstrated as inhibiting IGH-IR. The rejection is respectfully traversed, and withdrawal is requested.

Entry of this Response is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this response or application.

Respectfully submitted,

Novartis Institutes for BioMedical Research, Inc.
220 Massachusetts Avenue
Cambridge, MA 02139
(617) 871-7347


Mark Baron
Attorney for Applicants
Reg. No. 46,150

Date: 18 February 2009